

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID ROTH, JOAKIM AHLSTROM, DAVID GOETZ,
and PAUL H. GLAD

Appeal No. 2005-2311
Application No. 09/024,885

ON BRIEF



Before HAIRSTON, JERRY SMITH, and RUGGIERO, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the Examiner's rejection of claims 80-85, 94, 117-126, 133-140, and 150-156.

The claimed invention relates to a receptacle module for interfacing with a communications line. The receptacle module includes a portion for removable insertion into a card body to form a unitary module. In a further embodiment, a sliding drawer

is moveably coupled with the card body to open and retract with a recess positioned in the sliding drawer to receive an RJ-xx series plug. A moveable bottom of the sliding drawer moves downward when the siding door is open to receive the RJ-xx series plug, thereby acting to shield the electrical conductors of the plug from the surrounding environment.

Claims 80 and 124 are illustrative of the invention and read as follows:

80. A device comprising:

a card body;

a receptacle module to interface with a communications line, the receptacle module having a portion for removable insertion into the card body to form a unitary module; and

an overall length of the unitary module, in a configuration, that is within the PCMCIA Type III standard.

124. A device comprising:

a card body;

a sliding drawer moveably coupled with the card body to open and retract;

a recess positioned in the sliding drawer to receive an RJ-xx series plug when the sliding drawer is open; and

a moveable bottom of the sliding drawer to move downward when the sliding drawer is open to receive the RJ-xx series plug and to shield electrical conductors of the plug from a surrounding environment.

The Examiner relies on the following prior art:

Hardesty	4,241,974	Dec. 30, 1980
Aldous et al. (Aldous)	5,183,404	Feb. 02, 1993
Okada	5,395,268	Mar. 07, 1995

"Integrated Services Digital Network (ISDN) Cable Terminator/Filter Device," Research Disclosure, page unnumbered (No. 317, Kenneth Mason Publ'ns., Ltd., England, Sep. 1990) (hereinafter referred to as "Research Disclosure").

Claims 80-85, 94, 117-123, and 133-140 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Aldous in view of Hardesty and Research Disclosure. Claims 124-126 and 150-156 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Aldous in view of Okada.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Brief (filed October 12, 2004) and Answer (mailed February 3, 2005) for the respective details.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the Examiner and the evidence of obviousness relied upon by the Examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellants' arguments

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set forth in the Brief along with the Examiner's rationale in support of the rejection and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 80-85, 94, 117-126, 133-140, and 150-156. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044,

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1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

With respect to the Examiner's 35 U.S.C. § 103(a) rejection of appealed independent claims 80, 133, and 139 based on the combination of Aldous, Hardesty, and Research Disclosure, Appellants assert that the Examiner has failed to establish a prima facie case of obviousness since all of the claimed limitations are not taught or suggested by the applied prior art references. After reviewing the arguments of record from Appellants and the Examiner, we are in general agreement with Appellants' position as stated in the Brief.

We agree with Appellants that, although the Examiner has cited the Hardesty and Research Disclosure references as providing a teaching of the claimed removable reception module features, proper motivation for the proposed combination with

Aldous has not been established. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992).

As pointed out by Appellants (Brief, pages 7 and 8), Aldous is directed to various techniques for providing RJ-11 compatible receptacles. On the other hand, the disclosure of Hardesty, for example, is directed to an adapter/splitter for connecting two telephone cards to a wall terminal. The Research Disclosure document is also directed to a termination device, used in ISDN communications networks, with differing plug-jack configurations enabling straight line or right angle connections. In our view, given the disparity of problems addressed by the applied prior art references, and the differing solutions proposed by them, any attempt to combine them in the manner proposed by the Examiner could only come from Appellants' own disclosure and not from any teaching or suggestion in the references themselves.

Accordingly, since we are of the opinion that the Examiner has not established a prima facie case of obviousness since all of the claimed limitations are not taught or suggested by the applied Aldous, Hardesty, and Research Disclosure references, we

do not sustain the rejection of independent claims 80, 133, and 139, nor of claims 81-85, 94, 117-123, 134-138, and 140 dependent thereon.

Turning to a consideration of the Examiner's 35 U.S.C. § 103(a) rejection of claims 124-126 and 150-156 based on the combination of Aldous and Okada, we do not sustain this rejection as well. We agree with Appellants (Brief, pages 10 and 11) that Okada's teaching of providing a box with a moveable bottom to act as a stop for the insertion of a modular plug does not establish any motivation for a combination with Aldous since Aldous already provides for a stop, in the form of ledge 126 (Figure 15 of Aldous) which functions to prevent "passage of the contact pin block completely through the aperture in the communications card." (Aldous, column 17, lines 17-22). Given this deficiency in the disclosures of the applied prior art, we can find no teaching or suggestion, and the Examiner has pointed to none, as to how and in what manner the Aldous and Okada references might be combined to arrive at the claimed invention.

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In summary, we have not sustained the Examiner's 35 U.S.C. § 103(a) rejections of any of the claims on appeal. Therefore, the decision of the Examiner rejecting claims 80-85, 94, 117-126, 133-140, and 150-156 is reversed.

REVERSED



KENNETH W. HAIRSTON)
Administrative Patent Judge)
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JERRY SMITH)
Administrative Patent Judge)
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